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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,255	11/16/2001	Ken Johnson	6634.02	3008

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EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/991,255	Applicant(s) JOHNSON, KEN	
	Examiner JAGDISH PATEL	Art Unit 3624	<i>MW</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to after final amendment filed 5/20/04.

Response to Amendment

2. Claims 1, and 10 have been amended per request. Presently claims 1-13 and 20-22 are pending.

3. Finality of the prior office action has been withdrawn.

Response to Arguments

4. Applicant's argument that Lockwood reference fails to teach limitation of "altering the terms depending on results of a credit check" are persuasive. Accordingly, Lockwood reference has been removed from the 103(a) rejection and has been substituted by a new reference based upon a new prior art search.

5. In regard to claims 10 the applicant's arguments are not persuasive because the claim recites an apparatus having an user interface for interactively inputting lease related information by a user and altering the lease related information..., this interface is inherent to the cited reference of www.saturn.com which interacts with the customer computer via the user interface. The user altering the lease related information (based on results of an automated credit check) does not alter the functionality of

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the server which is adapted to receive the lease related information whether altered or not. The cited reference therefore is effective reference against the amended claim.

6. Since this office action is issued to address only the applicant's prior amendment (no substantive amendment is presented in the after final amendment) the finality of this office action is proper.

Claim Objections

7. Claims 1-9 are objected to because of the following informalities: The application of term "client" in the claims is misleading since the client is intended to communicate the information regarding the lease electronically. It is suggested that the claims clearly show that such communication is carried out with a computer at the client which is connected to the server.

Appropriate correction is required.

Statute Cited in Prior Action

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

9. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over PR Newswire (Saturn Takes a Major Steps Forward in On-Line Electronic Commerce), April 30, 1998 (Newswire) and further in view of Brescia, Andrea; Credit bureaus add bankruptcy prediction tools, Computers in Banking v6, n5, p14(2) May 1989. (Brescia)

Per claim 1, Newswire discloses an automated method for generating a quote for a piece of leased equipment, (vehicle selection and pricing), the method comprising:

(a) electronically soliciting from a client terms for a lease for a piece of leased equipment ... (Saturn interactive pricing center offers lease terms that fit user's budget p.1, .."a Saturn guest can ..change financing terms and can see ..");

(b) electronically receiving and storing.. the terms for the lease (inherent to Saturn interactive pricing center as disclosed which is Internet based implemented via the disclosed web site www.saturn.com, in which case the client specified terms for a lease of a vehicle are received at a web server);

(c) computing payment terms based for the lease based on the terms of the lease and a desired rate for

the lease ("Saturn guest" can see payment terms in response to selected changes in payment terms and can adjust lease terms to fit their budget) and;

(d) generating report at the client showing the payment terms for the lease (Saturn interactive pricing center generates a report showing the payment terms for the lease because the client is able to interact with the Saturn web site to receive lease term information).

The Newswire article which recites an interactive, web-based method for automatically generating a quote for a leased equipment, however, fails to teach that the lease terms solicited include a cost and residual value and down payment information.

Official notice is taken that a cost and residual value and down payment, term for the lease (months or years), down payment and residual value are old and well known parameters. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Newswire so a plurality of terms and conditions are available to a client for selecting a lease product because it would allow a client to customize a lease that best meets his financial requirements.

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Newsire and the official notice fail to disclose the step of altering the quote (payment terms) depending on results of a credit check.

Brescia, in the same field of endeavor, teaches that terms of a loan or credit based on the results of the result of a credit check (see abstract and p. 2 third paragraph "the score allows..to alter terms of the loan or credit").

It would have been obvious to one of ordinary skill in the art at the time of invention to provide the capability of altering the terms depending on the results of a credit check because it would maintain the terms of lease consistent with the client's credit worthiness, thereby maximize risk versus reward tradeoff as explicitly disclosed by Brescia.

Claim 2: the act of generating documentation for the piece of leased equipment such a user may complete the documentation (p.2 summary of the finances selected, which may be used by a dealer to complete a sale of a vehicle).

Claims 3 and 4 : terms for lease include a capital cost, a residual, a dealer fee, a documentation fee, upfront fees, length of lease in months and type of asset (these are customary items of a lease agreement and are anticipated by the applied references). Claim 4 is similarly analyzed as claim 3.

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Claim 5: ..receiving the terms for the lease Over the Internet (inherent in Newswire because the method for generating a quote is implemented over the Internet).

Claims 6: Newswire (or alternatively Dykstra) fails to teach that electronically receiving the information through an interactive telephone response system. However, official notice is taken that conducting business transactions over the interactive telephone response system (such as receiving quotes for merchandise, ordering merchandise, catalogue ordering) is old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to carryout the lease process as disclosed in Newswire reference using an interactive telephone response system (as an alternative to the Internet access) because allowing access over the interactive telephone response system would enable clients who do not have access to a networked computer system to access the leasing system via a telephone network such as PBX. This would also thus allow more potential customers access to the lease server.

10. Claims 7-9, 11, 12 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over PR Newswire as

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applied to claim 1 and further in view of Dykstra and further in view of Brescia.

Claim 7: Refer to claim 1 analysis for limitations (a)-(e). Note that instruction from a client to go forward with the lease is inherent Newswire as being the case when the terms of the lease were acceptable.

Steps (f) through (j) are customary steps for determining credit worthiness for lease or purchase of a property. Newswire fails to disclose these steps. However, in the same field of endeavor, Dykstra teaches an automated method of credit evaluation and loan processing system.

Dykstra teaches:

(f) and (g) electronically soliciting from the lessee... the client basic identification information...individual user of the leased vehicle [col. 4 L 42-47, information pertaining to the potential borrower]; for receiving and storing in the server the client basic identification information, [col. 4 L 42-52, loan application database 108];

(h) scoring the lessee's credit using external credit score checking databases (refer to steps 110-114 of Fig. 2A, also refer to col. 4 last paragraph);

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(i) and (j) providing a credit report to the client detailing a credit score for the lessee and generating documentation for the vehicle lease such that the user at the client may complete the documentation (col. 5 L 3-24 credit report is displayed to the point of purchase terminal 26, the decision is sent to the merchant..the borrower can take a copy of the approval to the lender for verification and sign the papers for the loan).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Newswire and Dykstra references for their respective teachings so as to obtain a comprehensive method that would provide to the client payment terms for a customized lease (based on selected lease terms of personal choice) and subsequently apply for credit for a selected lease and complete the lease transaction based on the credit report provided to the client.

Newswire and Dykstra references as discussed above fail to recite altering the terms for the vehicle lease depending of the results of the credit report. However, Brescia teaches altering the terms for the vehicle lease (broadly interpreted as credit or loan instrument)

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depending of the results of the credit report as explained in claim 1 analysis.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide the capability of altering the terms depending on the results of a credit check because it would provide the creditor to adjust the terms of lease consistent with changes in the client's credit worthiness and maximize risk versus reward tradeoff as explicitly indicated by Brescia.

Claim 8. Refer to claim 5 analysis.

Claim 9. Refer to claim 6 analysis.

11. Claim 10 is rejected under rejected under 35 U.S.C. 103(a) as being unpatentable over Newswire.

Claim 10: Newswire discloses an automated system for generating a quote for a piece of leased equipment (vehicle), the system comprising:

A user interface (the vehicle selection and pricing system allows user to add or delete options or change financing terms, see p. 1, also it is noted that the user interface for interactively inputting lease related information and altering the lease related information, noting that the user via his or her computer interface may input or alter any information as desired);

A server adapted to electronically receive the terms of a lease from the user interface, store and process

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the lease related information and generate reports indicating the lease related information(see p.1 the vehicle selection and pricing system is Internet based, inherently the web site www.saturn.com is a server which receives the financing terms, the server also stores this information because it allows the user to send the "information" to a local retailer, the server also processes the terms and generates quote in the form of payment terms as it responds to the user's changing the terms of the lease);

A communication path ... (inherent to a web based automated system of www.saturn.com).

The Newswire doesn't expressly show that the user interface is capable of allowing a user to interactively input lease related information and alter the lease related information depending on the results of an automated credit check. However, it is noted that functionality of the user interface does not functionally relate to any other limitation of the system, i.e. limitations (b) and (c) would function as per the claimed invention regardless of the capabilities of the user interface as recited. Also it is noted that the user interface (intended) for performing certain function(s) does not means it actually performs such functions. Therefore this limitation is the

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attributes of the user interface is directed to the information content qualify as *descriptive material*.

However these differences are only found in the *nonfunctional descriptive material* and are not *functionally* involved in the other recited means of the system (server or communication path) as explained. Thus, this *descriptive material* will not distinguish the claimed invention from the prior art in terms of patentability see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have included any type of user interface which would provide the terms of the lease because the claimed user interface does not functionally relate to the system claimed and because the intended use of the user interface does not patentably distinguish the claimed invention.

Claim 11: Refer to analysis of step (h) of claim 7. All other limitations have been discussed in claim 10 analysis.

Claim 12: an external server for communication between the user interface and the server.

Newswire, fails to disclose external server between the user interface and the server. However, in the same field of endeavor, Dykstra teaches an automated system for generating a quote for a leased

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equipment. (abstract) including an external server as per claim (refer to Fig. 1 block 38 is a credit bureau computer). It would have been obvious to one of ordinary skill in the art at the time of invention to have communication between the user interface and the server so as to determine credit analysis and/or determine eligibility of the user to complete the lease transaction. All other limitations of claim 12 have been analyzed as in claim 10.

Claim 13. refer to claim 1 analysis in combination with claim 10 analysis.

All limitations of system claim 20 have been analyzed as per corresponding method claim 7.

All limitations of claim 21 and 22 have been analyzed as per claims 15 and 16 respectively.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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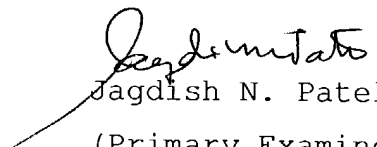
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (703)308-7837. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703)308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

7/9/04